

REMARKS/ARGUMENTS

This Amendment is responsive to the Final Office Action mailed August 30, 2007. A Request for Continued Examination and Declaration of Commercial Success are being filed concurrently herewith.

In this Amendment, 15 and 27-51 are pending. Claims 52-56 have been added. Support for the new and amended claims can be found in the specification. No new matter has been added. Entry of this Amendment and remarks is requested.

II. Rejections based on Williams et al. under 35 U.S.C. § 103(a)

Claims 15, 27-37, 39, 41-44 and 46-51 are rejected as obvious over Williams et al. (United States patent number 5,961,154) in view of Shea (United States patent number 5,383,994). Claim 38 is rejected as obvious over Williams et al. in view of Shea, and in further view of Shea et al. (United States patent number 5,505,497). Claim 40 is rejected as obvious over Williams et al. in view of Shea, and in further view of Nishio (United States patent number 6,045,164). The Examiner also states that claim 44 is obvious over Williams et al. in view of Shea, and in further view of Narukawa (United States patent number 4,433,020). However, as Applicants previously submitted in the previously filed Amendment dated June 28, 2007, based on the content of this last rejection, we will assume that the rejection of claim 44 actually refers to claim 45.

A. *Neither Williams et al., nor the secondary cited references, teach or suggest "an integral one-piece structure" slip collar.*

Applicant's respectfully acknowledge the Examiner's rejections of all previously pending claims. Applicants maintain and resubmit their position, as stated in the previously filed Amendment dated June 28, 2007, that Williams et al., alone or in combination with the other

cited references, does not teach or suggest "a slip collar that is an integral, one-piece structure" as recited in independent claims 15 and 36. As such, the cited references do not anticipate nor render obvious the claimed duct assembly.

B. Declarations of commercial success and structural advantages submitted to support existence of non-obvious differences over the cited references.

The embodiments of the claimed invention provide for non-obvious structural differences from and economic advantages over the duct assembly of Williams et al. In support, Applicants have previously submitted the Declaration of Jeff Shea as to the commercial success of product embodiments of the claimed invention ("the First Shea Declaration") and the Declaration of Joseph Plecnik as to structural advantages of the claimed invention ("the Plecnik Declaration") pursuant to 37 C.F.R. § 1.132.

In regard to the Examiner's objection to the Plecnik Declaration that it provides no objective evidence of the structural advantages that distinguish the structure from the cited references, Applicants respectfully disagree. As submitted in previous Amendment dated October 9, 2006, the Plecnik Declaration is evidence, as it contains opinions by an unbiased third-party declarant with relevant knowledge. See MEPE 716.01(c)III. Accordingly, the Examiner's allegation that the Plecnik Declaration somehow is not evidence is directly contrary to the MPEP.

Applicants respectfully acknowledge the Examiner's objection to the previously filed First Shea Declaration and Plecnik Declaration. The Examiner states that the First Shea Declaration lacked an objective nexus to the claimed invention because the evidence of commercial success is not commensurate in scope with the claims and there is no showing that the commercial success is derived from the claimed invention. Applicant's respectfully disagree with the Examiner's position in this regard.

According to MPEP § 716.03(b)IV, objective evidence must be provided showing specific commercial success with relation to market evidence such as market share, time period

during which sold, or what sales would normally be expected in the market.¹ The First Shea Declaration does demonstrate a nexus by showing an objective increase of sales over a definite time period as required by the MPEP. The MPEP does not require Applicants to also demonstrate gross sales with relation to market share and normally expected sales in addition the time period of the sales. The language in the § 716.03(b)IV is clearly in the alternative. As such, Applicants have demonstrated that the claimed features of the invention, as embodied in the H-Collars™, are responsible for the commercial success.

However, to further support the proposition that embodiments of the claimed invention comprise non-obvious differences over the cited references, Applicants currently submit the Second Declaration of Jeff Shea as to the commercial success of product embodiments of the claimed invention ("the Second Shea Declaration") pursuant to 37 C.F.R. § 1.132. In accordance with the guidelines of MPEP § 716.03, the Second Shea Declaration provides additional market share data to support the proposition that the commercial success of the H-Collar™ line of products made according to embodiments of the claimed invention is due to the technical advantages provided by the inventive features of the claimed invention. (Second Shea Declaration, paragraph 7).

As stated in the Second Shea Declaration, sales of H-Collar™ line of joint products made according to embodiments of the claimed invention have increased significantly since their introduction. (Second Shea Declaration, paragraph 6). This increase is not due to the Assignee's dominate market share or extensive marketing efforts. (Second Shea Declaration, paragraph 4; First Shea Declaration, paragraph 7). Rather, the increase in sales of the H-Collar™ line of joint products, is due to the inventive features of the claimed invention, and the technical advantages that flow therefrom. (Second Shea Declaration, paragraphs 5 and 7). Commercial success of products falling within the claims of the patent that flow from the

¹ In the Office Action dated August, 30, 2007, Applicants respectfully submit that the Examiner mistakenly cited the language of MPEP § 716.03(b)IV to require commercial success with relation to market share, time period and what normal sales would normally be expected. That section states that "[g]ross sales figures do not show commercial success absent evidence as to market share, or as to the time period during which the product was sold, or as to what sales would normally be expected in the market." (emphasis added and internal citations omitted.) Clearly, evidence of gross sales in combination with one of the stated conditions in the alternative is evidence of commercial success due to the inventive features of the claimed invention.

functions and advantages disclosed or inherent in the description in the specification is pertinent to the issue of non-obviousness. As previously stated in the Amendment dated June 28, 2007, it is clear that the commercial success is due to the many structural and economic advantages of the claimed invention. As such, the claimed invention which includes an "integral, one-piece" slip collar is non-obvious over Williams et al. in view of the cited secondary references.

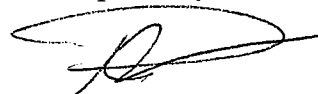
Accordingly, Applicants respectfully submit that in view of the Applicants' amendments and remarks, the First and Second Shea Declarations and the Plecnik Declaration, that the present claims are patentable and should be allowed.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



Patrick R. Jewik
Reg. No. 40,456

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
MRK:mrk
61174730 v1